REMARKS

Claims 1, 2, 8, 9, 13, and 17 are amended. Claim 3 was previously canceled without prejudice or disclaimer. Claims 1-2 and 4-20 are pending. No new matter is added by these amendments. By amending and canceling the claims, applicants are not conceding that the claims are non-statutory under 35 U.S.C. 101, 112, and 103, and are not conceding that the claims are unpatentable over the references cited by the Office Action, as the present claim amendments are only for the purpose of facilitating expeditious prosecution. Applicant respectfully reserves the right to pursue these and other claims in one or more continuation and/or divisional applications. Applicant respectfully requests reconsideration and allowance of all claims in view of the amendments above and the remarks that follow.

Applicant respectfully traverses to the Office Action assertion that "the method will never be invoked because it has not actually been added as part of the application." Applicant's claims do not specify the location of the created method or whether or not the method is ever invoked, so the claims read on created methods regardless of their location and regardless of whether they are invoked when the application is executed.

35 U.S.C. 101 Rejections

Claims 8-12 are rejected under 35 U.S.C. 101 because "The Specification, page 7, lines 22, discloses that the means may be implemented using any suitable hardware and/or software. As such, a software embodiment is disclosed, which is a non-statutory embodiment of 'software per se.'"

Applicant respectfully traverses these grounds for rejection for the reasons argued below. First, applicant's specification does not use the phrase "software per se." Second, the Office Action provides neither a definition for "software per se" nor a reason why

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"software per se," even if it were to be used, is non-statutory. Third, claims 8-12 include means plus function language (e.g., the functions of "receiving," "determining," "creating," "replacing," and "performing"), and MPEP 2106 (II) (C) recites:

> "Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and 'equivalents thereof' that correspond to the recited function. Two *en banc* decisions of the Federal Circuit have made clear that the USPTO is to interpret means plus function language according to 35 U.S.C. § 112, sixth paragraph. In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc); In re Alappat, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (en banc)."

Applicant's specification at page 3, last full paragraph (lines 19-23); page 3, last partial paragraph (lines 24-25); page 4, first partial paragraph and last partial paragraph (lines 1-28); page 5, first and second full paragraphs (lines 4-18); page 7, last partial paragraph (lines 22-28); and page 8, first partial paragraph and first full paragraph (lines 1-13) recites, in pertinent part:

> "Figure 1 depicts a high-level block diagram of an example system 100 for implementing an embodiment of the invention. The system 100 includes an electronic device 102 connected to a network 105. ...
>
> The electronic device 102 includes a processor 110, a storage device 115, an input device 120, and an output device 122, all connected directly or indirectly via a bus 125. The processor 110 represents a central processing unit of any type of architecture, such as a CISC (Complex Instruction Set Computing), RISC (Reduced Instruction Set Computing), VLIW (Very Long Instruction Word), or a hybrid architecture, although any appropriate processor may be used. The processor 110 executes instructions and includes that portion of the electronic

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device 102 that controls the operation of the entire electronic device. Although not depicted in Figure 1, the processor 110 typically includes a control unit that organizes data and program storage in memory and transfers data and other information between the various parts of the electronic device 102. The processor 110 reads and/or writes code and data to/from the storage device 115, the network 105, the input device 120, and/or the output device 122. ...

The storage device 115 represents one or more mechanisms for storing data. For example, the storage device 115 may include read only memory (ROM), random access memory (RAM), magnetic disk storage media, optical storage media, flash memory devices, and/or other machine-readable media. In other embodiments, any appropriate type of storage device may be used. ...

The storage device 115 includes an Integrated Development Environment (IDE) and an application 128, both of which may in various embodiments exist in any number. ...

The Integrated Development Environment 126 includes an editor capable of manipulating the code in the application 128. In an embodiment, the Integrated Development Environment 126 includes instructions capable of executing on the processor 110 or statements capable of being interpreted by instructions executing on the processor 110 to present the user interface as further described below with reference to Figure 2 and to perform the functions as further described below with reference to Figures 3, 4, and 5. In another embodiment, the Integrated Development Environment 126 may be implemented in hardware via logic gates and/or other appropriate hardware techniques in lieu of or in addition to a processor-based system.

...

The electronic device 102 may be implemented using any suitable hardware and/or software, such as a personal computer. Portable computers, laptop or notebook computers, PDAs (Personal Digital Assistants), pocket

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computers, telephones, pagers, automobiles, teleconferencing systems, appliances, and mainframe computers are examples of other possible configurations. The hardware and software depicted in Figure 1 may vary for specific applications and may include more or fewer elements than those depicted. For example, other peripheral devices such as audio adapters, or chip programming devices, such as EPROM (Erasable Programmable Read-Only Memory) programming devices may be used in addition to or in place of the hardware already depicted.

The various software components illustrated in Figure 1 and implementing various embodiments of the invention may be implemented in a number of manners, including using various computer software applications, routines, components, programs, code, objects, modules, data structures, etc., referred to hereinafter as "computer programs," or simply "programs." The computer programs typically comprise one or more instructions that are resident at various times in various memory and storage devices in the electronic device 102, and that, when read and executed by one or more processors in the electronic device 102, cause the electronic device 102 to perform the steps necessary to execute steps or elements embodying the various aspects of an embodiment of the invention."

Thus, the means plus function language of claims 8-12 may be interpreted, by way of example and not of limitation, as a system, as an electronic device, as a processor, as a central processing that executes instructions, as a control unit, as a device, as read only memory (ROM), as random access memory (RAM), as magnetic disk storage media, as optical storage media, as flash memory devices, as instructions capable of executing on the processor or statements capable of being interpreted by instructions executing on the processor, as hardware, as logic gates, as a personal computer, as a portable computer, as a laptop or notebook computer, as a PDA (Personal Digital Assistant), as a pocket computer, as a telephone, as a pager, as an automobile, as a teleconferencing system, as an appliance, as a mainframe computer, and/or as one or more instructions that are resident at various times in various memory and storage

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devices in the electronic device, and that, when read and executed by one or more processors in the electronic device, cause the electronic device to perform the steps necessary to execute steps or elements embodying the various aspects of an embodiment of the invention, all of which are physical components, structures, articles, or materials. Thus, applicant's specification discloses physical structures or materials that correspond to the recited functions of the means plus function claims 8-12, so claims 8-12 do not lack the necessary physical components, articles, or objects to constitute a machine or manufacture and are statutory under 35 U.S.C. 101.

Claim Rejections under 35 U.S.C. 112

Claims 1, 8, 13, and 17 are rejected under 35 U.S.C. 112 "as being incomplete for omitting essential steps." Claims 1, 8, 13, and 17 are amended to add "in response to," which is statutory under 35 U.S.C. 112.

Claim 2 is rejected under 35 U.S.C. 112 because "the block of code at a copy location in the application" has "insufficient antecedent basis." Applicant traverses these grounds for rejection for the reasons argued below. "The block of code" finds antecedent in "a block of code" in the phrase "receiving an operation, a selection of a block of code in an application, and a selection of a paste location in the application." (emphasis added.) "A copy location" provides its own antecedent basis. "The application" finds antecedent basis in "receiving an operation, a selection of a block of code in an application, and a selection of a paste location in the application." (emphasis added.)

Claims 8 and 13 are rejected under 35 U.S.C. 112 because "it is unclear whether 'replacing the block of code' refers to the previous line, 'a method that comprises the block of code', or does it reference 'a selection of a block of code in an application?'" Claims 8 and 13 are amended to recite: "replacing the block of code in the application," which is statutory under 35. U.S.C. 112.

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Claim Rejections under 35 U.S.C. 103

Claims 1, 2, and 4-20 are rejected under 35 U.S.C. 103(a) as unpatentable over Hiew (US Patent 7,110,936) in view of Hunt (US Pub. No. 2002/0032804). Applicant respectfully submits that the claims are patentable over Hiew and Hunt because not all of the claims elements are taught or suggested by Hiew and Hunt for the reasons argued below.

Claim 1 recites: "receiving an operation, a selection of a block of code in an application, and a selection of a paste location in the application; in response to the receiving, determining whether the block of code has a size greater than a threshold; if the block of code has a size greater than the threshold, creating a method that comprises the block of code and adding a first invocation of the method at the paste location; and if the block of code does not have a size greater than the threshold, performing the operation."

Hiew at column 7, line 5 describes "copying and pasting data," but Hiew contains no teaching or suggestion that its copying and pasting is done in response to any condition, let alone "whether the block of code has a size greater than a threshold," as recited in claim 1. Thus, Hiew merely describes imperative or unconditional copying and pasting and does not teach or suggest copying and pasting that is dependent on "whether the block of code has a size greater than a threshold." Thus, Hiew does not teach or suggest "if the block of code does not have a size greater than the threshold, performing the operation," as recited in claim 1. Hiew also does not teach or suggest "if the block of code has a size greater than the threshold, creating a method that comprises the block of code and adding a first invocation of the method at the paste location," as recited in claim 1 because Hiew makes no determination that a block of code has a size greater than a threshold and does not teach or suggest "creating a method that comprises the block of code and adding a first invocation of the method at the paste location."

Hunt at [0263] describes replacing "the first few instructions 502 of the target function 500 ... with a jump instruction 504," but Hunt's "replacing" is imperative, is

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unconditional, and is not conditional on "whether the block of code has a size greater than a threshold," as recited in claim 1.

Thus, the combination of Hiew and Hunt does not teach or suggest "determining whether the block of code has a size greater than a threshold," as recited in claim 1. Further, the combination of Hiew and Hunt does not teach or suggest: "if the block of code has a size greater than the threshold, creating a method that comprises the block of code and adding a first invocation of the method at the paste location," as recited in claim 1. Further, the combination of Hiew and Hunt does not teach or suggest: "if the block of code does not have a size greater than the threshold, performing the operation," as recited in claim 1.

Claims 8, 13, and 17 recite similar elements as argued above for claim 1 and are patentable over Hiew and Hunt for similar reasons. Claims 2-7, 9-12, 14-16, and 18-20 are dependent on claims 1, 8, 13, and 17, respectively, and are patentable over Hiew and Hunt for the reasons argued above, plus the elements in the claims.
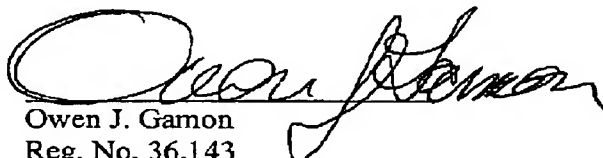
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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is requested. The Examiner is invited to telephone applicant's attorney (651-645-7135) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 09-0465.

Respectfully submitted,

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Name   Signature

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